

## REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

In view of Applicants' appeal brief filed on August 6, 2008, the Examiner has decided to reopen the prosecution, giving Applicants the choice to either: (1) file a reply under 37 CFR § 1.111 or 1.113; or (2) initiate a new appeal by filing a Notice of Appeal followed in due course by an appeal brief. At this time, Applicants elect to exercise option (1).

In this regard, Applicants believe that under the current state of the law, this application is in condition for immediate allowance as, hopefully, will be made clear with the following comments.

Before turning to the substantive issues, Applicants point out that they have added new claim 6, which is based on the description on page 25, lines 10-15. There is the teaching that straight cross-diecutting leads to a maximum dispensing rate of 0.3 m/s (page 25, lines 10-11), whereas undular cross-diecutting is more effective, leading to a maximum rate of 2.0 m/s. That means the difference in rates is the area between greater than 0.3 m/s to a maximum of 2.0 m/s. Exactly this area is claimed in new claim 6 and, therefore, new claim 6 is not believed to introduce any new matter. An early notice to that effect is earnestly solicited.

Claims 1-4 stand rejected under 35 USC § 103(a) as being obvious over Khatib, US 5,370,420, in view of Treleaven, US 6,413,345.

Claim 5 stands rejected under 35 USC § 103(a) as being obvious over Khatib in view of Treleaven and further in view of Bausewein et al. ("Bausewein"), US 5,482,779.

In response to **both** obviousness rejections, Applicants point to the last paragraph on page 6 of the Office Action and to the first paragraph on page 7. There, the Examiner discusses Applicants' data in the specification, the Examiner ultimately finding that "applicant's alleged surprising and unexpected results are **irrelevant** since the limitations are not recited in the rejected claims."

Applicants believe that the Examiner's position is contrary to well-established law. In this regard, Applicants call the attention of the Examiner once again to the decision in *In re Merchant*, 197 USPQ 785, 788 (CCPA 1978), for the proposition that a claim need not recite the unexpected results of a process so long as the structural features which are responsible for the unexpected results are recited in the claim. Indeed, the examiner in *Merchant* took a position similar to the Examiner's position here, i.e., that the unexpected results were not recited in the claims. However, the Court took a firm position that there is no such requirement in the patent law, holding:

"Finally, the solicitor repeats the objection voiced by the examiner that the declaration is **irrelevant** because *the claims specify neither the unexpected result nor the 'features' that produce that result.* ***We are aware of no law requiring that unexpected results relied on for patentability be recited in the claims.*** The 'features' referred to by the examiner are the conditions of pressure, feed rate, and reactor retention time for the commercial operation described in the declaration. We are equally unaware of any law requiring that commercial production parameters be claimed. Moreover, the 'feature' responsible for appellant's unexpected results is recited in the claims, viz., 'substantially anhydrous.' [All emphasis added.]"

In the present case, Applicants' data on page 25 of the specification demonstrate the unexpected result that improvement in diecut application speed that can be gained by using a non-straight line cut as opposed to a straight-line cut. The instant claims expressly require that the "diecutting line [be] a non-branching line having a form other than that of a straight line." Accordingly, analogous to the situation in *Merchant*, the feature that is responsible for Applicants' unexpected improvement in results, i.e., a diecutting line being a non-branching line having a form other than that of a straight line, is, in fact, recited in the instant claims. Following *Merchant*, the properties that flow from this claimed feature, i.e., the improved diecut application speed, are not only relevant, but must be considered.

As noted above, Applicants have cited *Merchant* to the Examiner before. Please see the first full paragraph on page 4 of the amendment dated November 22, 2006. The responsive Office Action of March 20, 2007, did not respond to this argument. If this rejection is maintained, then Applicants respectfully request that the Examiner respond to the *Merchant* decision in the next Office Action.

Further, the combination of Khatib and Treleven suffers the same defects as the previous combination of Hoffmann and Treleven and Applicants respectfully submit that the new combination also fails to make out a *prima facie* case of obviousness.

Finally, Applicants respectfully request special consideration be given to new claim 6, which, following the Examiner's logic, patentably distinguishes over the prior art in any event.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
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